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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/178,329	10/23/1998	MICHAEL R. NOWAK	053649-0003	4360

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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/178,329

Applicant(s)

NOWAK ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. The response and Declaration filed 4/1/03 have been entered. Claims 1, 5, 6 and 8-12 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claim 8 remains objected to because of the following informalities: “acrdylic” and “nylone” are misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. Claims 1, 5, 6, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lacy (USPN 3,480,464) for the reasons recited in the prior office action and restated below.

Lacy teaches a wrapping or packaging material comprising an extrusion coated paper wherein the a polyolefin layer is extruded onto a paper substrate and then a thin layer of metal is vapor deposited on the polyolefin layer (Abstract; Col. 4, lines 10-55.) Lacy teaches that the any type of paper and paper thickness can be employed as the substrate such as processed papers like Kraft paper and that the polyolefin layer is preferably polyethylene (Col. 3, lines 3-72.) Lacy teaches that the paper, polyolefin or metal layer can be provided with beneficial adhesion promoting agents such as a coating layer of PEI (Col. 4, line 64-Col. 5, line 9.) Lacy further teaches examples comprising a paper having a basis weight within the instantly claimed range, a polyethylene extruded layer on the paper having a PEI adhesion promoting layer on the surface and metallizing the polyethylene layer (Examples.)

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5. Claims 1, 5, 6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Eberl (USPN 3,010,860) for the reasons recited in the prior office action and restated below.

Eberl teaches a composite wrapping material comprising a paper base sheet with a basis weight of 16-32 lb ream weight, coated with an adherent hot melt wax coating and then covered with a synthetic resin sheet such as polyethylene or polypropylene wherein the wax is a refined paraffin wax or microcrystalline wax, i.e. polymer wax (Abstract; Col. 2 – Col. 3, line 12; Col. 3, lines 20-47.)

6. Claims 1, 5, 6, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitagawa (USPN 4,242,418) for the reasons recited in the prior office action and restated below.

Kitagawa teaches a polyolefin-paper composition comprising a styrene-butadiene acrylic copolymer as an adhesive layer between the polyolefin layer and the paper substrate; wherein the polyolefin layer comprises polyethylene and may further comprise pigments and wherein Kitagawa teaches examples comprising a paper basis weight of 100 g/m² which reads upon about 60 lbs/3000 sq ft as instantly claimed (Abstract; Col. 5, lines 34-64; Col. 6, lines 7-33; Col. 7, line 63-Col. 8, line 27; Examples.)

7. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Knauf (USPN 5,250,348) for the reasons recited in the prior office action and restated below.

Knauf teaches an improved wrapper paper for use in wrapping reams of paper wherein the wrapper comprises a base paper of about 30-about 60 lbs/3000 sq ft; a LDPE layer and wherein an optionally PEI layer can be applied to the paper web prior to application of the PE layer to enhance adherence of the PE to the paper web (Abstract; Col. 2, lines 64-67; Col. 3, lines 20-46; Col. 4, lines 21-47; Col. 8, lines 45-53; Figures.)

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8. Claims 1, 5, 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirose et al (USPN 4,584,234) for the reasons recited in the prior office action and restated below.

Hirose et al teaches a wrapping material comprising laminated layers of a paper support and at least one polyethylene resin layer superimposed on at least one surface of the paper support, and at least one layer of said wrapping material optionally comprising a light-shielding substance such as in the form of aluminum deposited on the surface of the paper (Abstract; Col. 4, lines 16-19; Figures.) Hirose et al teaches that an adhesive layer can be utilized between the paper support and the extruded polyethylene layer to improve adhesiveness (Col. 4, lines 41-55.) Hirose et al further teach an example utilizing a machined paper having a basis weight of 70 g/m² which falls within the instantly claimed range.

Claim Rejections - 35 USC § 103

9. Claims 1, 5, 6, and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyde (USPN 2,582,037) in view of Eberl for the reasons recited in the prior office action and restated below.

Hyde teaches a wax coated wrapping paper comprising a paper base with a wrapping weight of 15-150 lbs/ream (3000 sq ft), preferably 20-35 lbs/ream, and a polyethylene wax blend coating applied to the paper base (Abstract; Columns 2-3.) Hyde does not teach polyethylene film applied over the wax coating, however, Eberl teaches that by providing a thermoplastic film such as a polyethylene film over the wax coating and heating to adhere the film to the wax provides improved physical properties to the composite paper wrapping product over wax coated papers (Col. 1, lines 40-56; Col. 3, lines 48-63.) Therefore, one having ordinary skill in the art at

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the time of the invention would have been motivated to apply a polyethylene or other compatible thermoplastic film as taught by Eberl over the waxed paper substrate taught by Hyde to provide improved physical and mechanical properties to the paper composite. Further, it would have been obvious to one having ordinary skill in the art to provide desired pigments in any of the composite layer to provide a desired color based on a particular end use of the composite.

Response to Arguments

10. Applicant's arguments and declaration filed 4/1/03 have been considered but are not persuasive. With respect to Lacy, the Applicant argues that the instant invention does not require a metal layer, is formed from a solid polyolefin film and has heavier paper weights than Lacy; however, the Examiner notes that the instant invention does not exclude a metal layer given that it is drafted in "consisting essentially of" transition language and there is nothing on record to indicate that a metal layer would materially affect the basic and novel characteristics of the invention. Further, Lacy clearly discloses a basis weight that falls within the instantly claimed invention and hence anticipates the range. Lastly, with respect to Applicant's arguments regarding the claim limitation "said polymer film being solid during lamination to said paper", the Examiner notes that it is well established that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985.) Therefore,

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given that the second layer of the instant invention is a solid polymer film in the final product whether solid during lamination to the paper via an adhesive layer or extrusion laminated to the paper via an adhesive layer, the Examiner takes the position that the invention taught by Lacy reads upon the instantly claimed invention given that the final product of Lacy appears to be the same as the final product of the instant invention particularly given that the instant disclosure utilizes extrusion of the adhesive layer which would result in the same interfacial properties.

11. With respect to Eberl, the Applicant argues that the instant application does not require heating and blending of layers to produce the laminate, does not use wax coating, and is not used for food wrapping as taught by Eberl and that Eberl also teaches examples without paper. However, the Examiner does not find these arguments persuasive given that Eberl clearly discloses a composite utilizing paper with a basis weight within the instantly claimed range. Further, the Examiner takes the position that the wax coating acts as an adhesive agent between the paper and the polymer layer and hence reads upon the limitation "adhesive layer". In terms of heating and blending, the Examiner notes that the instant invention does not exclude these process limitations wherein the resulting product taught by Eberl is the same as instantly claimed and further given that the final product taught by Eberl appears to be the same as the instantly claimed invention, it is irrelevant whether the product is utilized for wrapping foods or wrapping reams of paper, given that the instant claim limitation "for wrapping reams of paper" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

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See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, the Examiner takes the position that the limitation “for wrapping reams of paper” is intended use of the composite wrap material wherein a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. With respect to Kitagawa, the Applicant argues that Kitagawa relates to light sensitive photographic papers, requires primer, and the plastic film layer is extruded in the molten form; however the Examiner notes that the instant invention does not exclude primers and the final product taught by Kitagawa is the same as the instant invention given that the limitation “said polymer film being solid” is a process limitation as discussed above and further the product is the same whether it relates to light sensitive photographic papers or wrapping reams of paper.

13. With respect to Knauf, the Applicant first argues that the adhesive layer is on the opposite side of the paper from the polymer layer however the Applicant admits on page 12, lines 8-13 of the response that Knauf teaches applying a polymer layer to the adhesive layer applied on the paper and hence Knauf discloses the same layer structure as instantly claimed. The Applicant further argues that Knauf teaches that the polymer layer is extruded and hence not in the solid state upon lamination, however as discussed in detail above, the Examiner takes the position that the resulting product is the same.

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14. With respect to Hirose, the Applicant argues that the instant claims require that the product is used for wrapping reams of paper, require a solid plastic film layer laminated to paper, and requires a particular basis weight, while arguing that Hirose requires light shielding material, involves extrusion lamination, and does not teach the basis weight range as instantly claimed. However, the Examiner notes that the instant invention does not exclude light shielding material and Hirose does in fact teach a basis weight that falls within the instantly claimed range thereby anticipating the claim limitation. Further, as discussed above, the product taught by Hirose formed by extruding the polymer layer would result in the same product as instantly claimed given that the layer structure and materials are the same.

15. With respect to the rejection based on Hyde in view of Eberl, the Applicant first argues that Hyde does not teach the instantly claimed basis weight range, however the Examiner notes that Hyde does in fact teach a basis weight that reads upon the claimed range. Further, it appears as if the Applicant is arguing the references separately as opposed to in combination as recited in the rejection. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hence, the Examiner maintains the rejection for the reasons recited in paragraph 9 above.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson
Patent Examiner
Technology Center 1700
June 16, 2003